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EXAMINER
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JOHNSON, JENNA LEIGH

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAMES M. SHEPPARD JR.

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Appeal 2009-015288  
Application 09/747,529  
Technology Center 1700

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Before JENNIFER D. BAHR, JOHN C. KERINS and  
STEVEN D.A. McCARTHY, *Administrative Patent Judges*.

McCARTHY, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

### STATEMENT OF THE CASE

The Appellant's claims being twice-rejected, the Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 21, 22, 24-27, 29, 30, 32-34 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Terrasse (US 2,163,769, issued Jun. 27, 1939) and Stark (US 3,669,818, issued Jun. 13, 1972); and rejecting claims 28 and 35 under § 103(a) as being unpatentable over Terrasse, Stark and Sherrill (US 3,721,273, issued Mar. 20, 1973). We have jurisdiction under 35 U.S.C. § 6(b).

1       We AFFIRM.

2       Claim 21, a product-by-process claim, is illustrative:

3           21.   A towel having a graphic impression,  
4           comprising:

5           weaving a towel on a jacquard loom using at least  
6           two different colors of yarn, such that

7                   a border having a first dark color is woven  
8                   adjacent each edge of said towel, on one  
9                   side thereof, and

10                   a border having a second lighter color is  
11                   woven adjacent each edge of said towel on  
12                   the other side,

13           said towel having a central area woven within said  
14           borders on both said one side and said other side,

15                   said central area is woven with said first  
16                   darker color on said other side

17                   said central area is woven with said second  
18                   lighter color on said one side;

19           wherein said border on said one side is capable of  
20           masking said graphic impression that may overlap  
21           onto said border from said central area on said one

1 side, eliminating the need for precise alignment of  
2 said graphic impression within said central area of  
3 said one side; and

4 wherein said central area on said other side is  
5 capable of masking any potential bleed through of  
6 said graphic impression from said central area of  
7 said one side.

8  
9 ISSUES

10 The Appellant presents an argument for the patentability of  
11 independent claim 29 separate from the argument presented by the Appellant  
12 in favor of the patentability of claim 21. Nevertheless, a comparison of the  
13 two arguments indicates that the Appellant's argument in favor of the  
14 patentability of claim 29 presents no issues separate from the issues arising  
15 in connection with the argument in favor of the patentability of claim 21.  
16 (*Compare* Br. 23 (setting out the argument in favor of the patentability  
17 of claim 29) *with* Br. 11 (stating the issues raised in connection with the  
18 patentability of claim 21 as perceived by the Appellant)). Therefore, the  
19 patentability of claims 21 and 29 will be addressed together. Since the  
20 pertinent limitations of claims 21 and 29 are virtually identical, only the  
21 limitations of claim 21 will be expressly discussed.

22 The Appellant expressly waives, for purposes of this appeal only, any  
23 argument for the patentability of dependent claims 22, 24-27, 30, 32-34 and  
24 36 separately from the patentability of independent claims 21 and 29. (Br.  
25 23). The Appellant does argue the patentability of dependent claims 28 and  
26 35 separately. Claim 28 is representative to claims 28 and 35. *See* 37  
27 C.F.R. § 41.37(c)(1)(vii).



1 undisputed that a towel, woven on a jacquard loom using at least two  
2 different colors of yarn, such that a border having a first dark color is woven  
3 adjacent each edge of said towel, on one side thereof, and a border having a  
4 second lighter color is woven adjacent each edge of said towel on the other  
5 side, said towel having a central area woven within said borders on both said  
6 one side and said other side, said central area is woven with said first darker  
7 color on said other side, said central area is woven with said second lighter  
8 color on said one side, would have been known to one of ordinary skill in  
9 the art.

10 3. The Examiner is correct as a matter of common sense in finding  
11 that “applying designs to white or light colored backgrounds [was] well  
12 known and commonly done” among lay persons, as well as by one of  
13 ordinary skill in the art, “because the design usually stands out best on a  
14 light background.” (*See* Ans. 4).

#### 16 PRINCIPLES OF LAW

17 In order to reject a claim under section 103(a), an examiner must  
18 establish at least a “prima facie” case that the claimed subject matter would  
19 have been obvious. Once the examiner produces prima facie evidence that  
20 the claimed subject matter would have been obvious, the applicant may  
21 present additional evidence tending to rebut the examiner’s conclusion that  
22 the claimed subject matter would have been obvious. If the applicant  
23 presents additional evidence to rebut the examiner’s conclusion, the  
24 examiner must consider all of the evidence anew. If the evidence presented  
25 by the examiner and any evidence presented by the applicant, considered  
26 anew, demonstrate that the claimed subject matter would have been obvious

1 to one of ordinary skill in the art, the claim is properly rejected under section  
2 103(a). *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

3 In order to establish a prima facie case of obviousness, an examiner  
4 must undertake the factual inquiries listed in *Graham v. John Deere Co.*, 383  
5 U.S. 1, 17-18 (1966). In addition, the examiner must articulate some  
6 “reasoning with some rational underpinning to support the legal conclusion  
7 of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). This  
8 reasoning must show that “there was an apparent reason to combine the  
9 known elements in the fashion claimed.” *KSR Int’l Co. v. Teleflex, Inc.*, 550  
10 U.S. 398, 418 (2007). The apparent reason need not appear in, or be  
11 suggested by, one or more of the references on which the examiner relies.  
12 Instead, the examiner when analyzing the evidence may employ common  
13 sense not inconsistent with the ordinary level of knowledge and skill in the  
14 art. *Perfect Web Techs. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328-29 (Fed. Cir.  
15 2009).

16 Claims 21, 28 and 29 recite products. Claims 21 and 28 recite towels  
17 while claim 29 recites a textile. Although claims 21 and 28 define  
18 the claimed towels in terms of methods for making those towels, the  
19 determination of whether the claimed towels would have been obvious  
20 must be made on the basis of the towels and their properties rather than  
21 the method steps by which the towels were produced. “If the product in a  
22 product-by-process claim is the same as or obvious from a product of the  
23 prior art, the claim is unpatentable even though the prior product was made  
24 by a different process.” *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985);  
25 *see also SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317  
26 (Fed. Cir. 2006).

Where claimed and prior art products are identical or substantially identical,

the [Patent and Trademark Office] can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of [the] claimed product. Whether the rejection is based on ‘inherency’ under 35 U.S.C. § 102, on ‘prima facie obviousness’ under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.

*In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (citations omitted); *see also In re Spada*, 911 F.2d 705, 708 (Fed Cir. 1990)(“[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.”)

## ANALYSIS

*First Issue*

Turning to claim 21, it is undisputed that a towel, woven on a jacquard loom using at least two different colors of yarn, such that a border having a first dark color is woven adjacent each edge of said towel, on one side thereof, and a border having a second lighter color is woven adjacent each edge of said towel on the other side, said towel having a central area woven within said borders on both said one side and said other side, said central area is woven with said first darker color on said other side said central area is woven with said second lighter color on said one side, would have been known to one of ordinary skill in the art. (FF 2). One such towel was disclosed by Terrasse. (FF 1).



1 Stark discloses that it was known in the art to print patterned pile  
2 fabrics in registry with sections of an existing pattern. (FF 1). More  
3 specifically, Stark discloses forming patterns on the surfaces of towels by  
4 high and low pile areas, or pile and no pile areas, on the surface of the towel.  
5 (Stark, col. 1, ll. 33-35). Stark also teaches that such patterns may be  
6 accented by employing yarns of different colors to produce various parts or  
7 sections of the fabrics during construction of the fabrics. (Stark, col. 1, ll.  
8 40-42). According to Stark, “[i]t is also known to print such patterned pile  
9 fabrics with various colors to accept [*sic*, accent] the pattern design in the  
10 fabric and further enhance the aesthetics of the product. Such printing is  
11 superimposed on the fabric in registry with sections of existing pattern in the  
12 surface of the fabric.” (Stark, col. 1, ll. 43-47).

13 “[I]f a technique has been used to improve one device, and a person  
14 of ordinary skill in the art would recognize that it would improve similar  
15 devices in the same way, using the technique is obvious unless its  
16 application is beyond his or her skill.” *KSR Int’l Co. v. Teleflex, Inc.*, 550  
17 U.S. 398, 417 (2007). Terrasse’s woven fabric and Stark’s terry towel are  
18 similar devices in the sense that both are textiles formed by processes  
19 including weaving. The teachings of Stark imply that one of ordinary skill  
20 in the art would have known to improve the aesthetics of a woven textile  
21 by the technique of printing a pattern design superimposed on a fabric in  
22 registry with a section or sections of an existing surface pattern formed from  
23 high and low pile areas, the use of different colored threads during weaving,  
24 or both. The Appellant provides no persuasive evidence that the technique  
25 of forming a graphical impression on a jacquard woven textile would have  
26 been beyond the level of ordinary skill in the art. As the Examiner expresses

1 it, it would have been obvious “to add a printed design as disclosed by Stark  
2 to the patterned fabric taught by Terrasse since Stark teaches that woven  
3 patterned fabrics can be enriched by applying a printed pattern to the fabric  
4 which enhances the desirability of the end product.” (Ans. 4).

5 One of ordinary skill in the art also would have had reason to form a  
6 pattern design or graphic impression specifically on the lighter colored (that  
7 is, white) central area of the towel disclosed by Terrasse.

8 Common sense implies that even a lay person, much less one of ordinary  
9 skill in the art, would have known to apply such a pattern design to a white  
10 or light colored background because the design would have stood out best on  
11 a light background. This would particularly have been true of a design  
12 including a darker color. This common sense would have provided one of  
13 ordinary skill in the art reason to apply the pattern design or graphic  
14 impression to the largest white or lighter colored background available on  
15 the surface of the towel, namely, the lighter colored central portion on the  
16 side of the towel depicted in Figure 1 of Terrasse.

17 The Examiner’s reliance on Terrasse and articulation of the basis for  
18 this common sense reason distinguishes this appeal from an earlier appeal in  
19 the same underlying application. In the opinion issued in Appeal 2009-  
20 1029, the Board agreed with the Appellant that both of the two references  
21 on which the Examiner relied in the earlier appeal failed to disclose

22 borders adjacent each edge of a towel or textile  
23 product and a central area within and surrounded  
24 by the borders, which central area on one side of  
25 the towel or textile product receives a graphic  
26 impression, and the failure of either of the applied  
27 patents to teach or suggest the particular color  
28

1 arrangement of the borders and central areas  
2 required in the claims on appeal.

3 (*Ex Parte Sheppard*, Appeal No. 2009-1029, Appl'n 09/747,529 slip op. at 4  
4 (July 14, 2004)). Here, Terrasse discloses "the particular color arrangement  
5 of the borders and central areas required in the claims on appeal." The  
6 Board further criticized "the examiner's bald conclusion that 'it would have  
7 been obvious to one of ordinary skill in the art to choose various printed  
8 designs, as well as choose where to place the printed image on the [prior art]  
9 product . . .'" (*Id.* at 4-5). Here, the Examiner has provided technical  
10 reasoning to support the conclusion of obviousness.

11  
12 *Second and Third Issues*

13 As the Examiner notes, claim 21 recites a towel in which the "border  
14 on said one side is *capable* of masking said graphic impression that may  
15 overlap onto said border from said central area on said one side, eliminating  
16 the need for precise alignment of said graphic impression within said central  
17 area of said one side." Likewise, the "central area on said other side is  
18 *capable* of masking any potential bleed through of said graphic impression  
19 from said central area of said one side."

20 The Appellant's Specification further discusses these features:

21 Placing the graphic impression in the center area of  
22 the preferred embodiment (dark border with light  
23 central area) provides advantages produced by the  
24 Jacquard woven process, namely, that on the front  
25 side of the Jacquard woven article, a light color  
26 area will appear, and on the reverse side of a  
27 Jacquard woven textile, the opposite color pattern  
28 would appear, that is, the central area would be  
29 dark in color with a light color border. This

1 permits transferring the graphic impression on the  
2 front side of the preferred embodiment in the light  
3 color central area to be as intense as is desired and  
4 in as many colors as is desired and should the  
5 printing pigments, inks, dyes, etc., bleed through to  
6 the reverse or back side of the textile article, the  
7 dark color would mask the bleed through such that  
8 it is not seen. If both sides of the textile article are  
9 screen printed, image dyed, digital imaging, or  
10 heat transferred one must be careful to prevent the  
11 dye, pigment, or paint employed on the back side  
12 of the textile article from bleeding through to the  
13 light color front side.

14 (Spec. 8). The Specification identifies white as a suitable light color and  
15 blue as a suitable dark color for the borders and central areas. (Spec. 7).

16 These disclosures imply that the property of the border whereby the  
17 border is “capable of masking said graphic impression that may overlap onto  
18 said border from said central area on said one side, eliminating the need for  
19 precise alignment of said graphic impression within said central area of said  
20 one side” flows naturally from the color pattern required by claim 21 and the  
21 formation of the graphic impression on the lighter colored central area of  
22 the one side. Likewise, the property of the central area whereby the central  
23 area is “capable of masking any potential bleed through of said graphic  
24 impression from said central area of said one side,” flows naturally from  
25 the same combination of features. Since one of ordinary skill in the art  
26 had reason to combine the color pattern required by claim 21 with a graphic  
27 impression formed on the lighter colored central area of the one side, the  
28 towel of claim 21 as a whole would have been obvious in view of the  
29 combined teachings of Terrasse and Stark. *See Ex Parte Obiaya*, 227 USPQ  
30 58, 60 (BPAI 1985)(“The fact that appellant has recognized another

1 advantage which would flow naturally from following the suggestions of the  
2 prior art cannot be the basis for patentability when the differences would  
3 otherwise be obvious.”).

4         At the least, the towel obvious in view of the combined teachings of  
5 Terrasse and Stark would have been structurally identical, or substantially  
6 structurally identical, to the embodiments described in the Specification.  
7 This identity, or substantial identity, implies that the Examiner has a sound  
8 basis for belief that a towel combining the color pattern required by claim 21  
9 with a graphic impression formed on the lighter colored central area of the  
10 one side necessarily would have a border and a central area possessing the  
11 capabilities recited in the latter part of claim 21. This sound basis for belief  
12 shifts the burden of production to the Appellant to show that a towel  
13 combining the color pattern required by claim 21 with a graphic impression  
14 formed on the lighter colored central area of the one side would not  
15 necessarily have a border and a central area possessing the capabilities  
16 recited in the latter part of claim 21. *See Best*. The Appellant has produced  
17 no persuasive evidence to meet this burden. The Examiner correctly  
18 concludes that a towel meeting the limitations of claim 21 as a whole would  
19 have been obvious.

20         Two decisions of the Board in related appeals, cited by the Appellant  
21 in the Appeal Brief (*see* Br. 3), are also distinguishable. In Appeal 2009-  
22 001515, the representative claim recited a method of making a printed textile  
23 article. (*See Ex Parte Sheppard*, Appeal 2009-001515, Appl’n 10/314,794  
24 slip op. at 2 (BPAI Jun. 30, 2009)). At issue in Appeal 2009-001515 was  
25 whether the steps of the recited method were obvious. Appeal 2009-001515  
26 raised no issue as to whether capabilities of a claimed a towel or textile

1 product might flow naturally, or might be inferred to be inherent, from  
2 identity or substantial identity with a prior art towel or textile product. Since  
3 the issues in the present appeal differ from those in Appeal 2009-001515, the  
4 holding of Appeal 2009-001515 is neither binding nor persuasive here.

5 In Appeal 2009-002790, the representative claim claimed a towel  
6 produced by recited method steps. (*Ex Parte Sheppard*, Appeal 2009-  
7 002790, Appl'n 09/837,094 slip op. at 2-3 (BPAI Jun. 18, 2009)). The  
8 representative claim was rejected under § 103(a) as being unpatentable over  
9 Stark, Parker (US 1,925,459, issued Sep. 5, 1933), Terasse and Sherrill. (*Id.*  
10 at 3). In reversing this rejection, the Board commented as follows:

11 We identify two problems with [the  
12 Examiner's] reasoning: (1) the Examiner has not  
13 pointed to any evidence of record that Stark  
14 provides for masking the overlap or bleed through  
15 of the printed graphic impression by the darker  
16 border and the darker central area on the back, and  
17 (2) the Examiner has not pointed to any evidence  
18 of record that Sherrill is concerned with  
19 misalignment or bleeding of the printed pattern on  
20 the cut pile surface. We also disagree with the  
21 Examiner's characterization of the functional  
22 limitations recited in claim 21 as merely related to  
23 the appearance and ornamentation of the fabric.

24 (*Id.* at 7). The Board also concluded that the Examiner "cited Terasse for  
25 teaching a woven fabric of a reversible pattern composed of two colors . . .  
26 and pointed to nothing in the reference that would provide a reason to  
27 combine such teachings with Stark, Parker, and Sherrill, or to compensate  
28 for the deficiencies of the combination discussed above." (*Id.* at 8).

29 The evidence and technical reasoning underlying the rejection of  
30 claim 21 in this appeal differ from those at issue in Appeal 2009-002790.

1 For example, the primary reference here is Terrasse rather than Stark. The  
2 Examiner relies on the color pattern shown in Figures 1 and 2 of Terrasse;  
3 technical reasoning explaining why it would have been obvious to form the  
4 graphical impression in the lighter colored central area shown in Figure 1 of  
5 Terrasse; and an inference as to the capabilities of the darker colored border  
6 depicted in Figure 1 of Terrasse and the darker colored central area depicted  
7 in Figure 2 of Terrasse, as evidence supporting the conclusion of  
8 obviousness. Since the evidence and reasoning on which the Examiner  
9 relies in the present appeal differs from those at issue in Appeal 2009-  
10 002790, the holding of Appeal 2009-002790 is neither binding nor  
11 persuasive here.

12  
13 *Fourth Issue*

14 With respect to representative claim 28, the Appellant argues that  
15 Sherrill fails to remedy perceived deficiencies in the combined teachings of  
16 Terrasse and Stark. (Br. 24). Since no such deficiencies exist, the argument  
17 is not persuasive.

18 Claim 28 depends from claim 21 and recites that “said towel is  
19 sheared and bloomed.” In the Appeal Brief, the Appellant states that:

20 Sherrill does describe a shearing step. See,  
21 e.g., col. 1, line 54-col. 2, line 3. See also col. 3,  
22 lines 61-col. 4, line 9 that explains that after the  
23 rayon loops are sheared they are free to spread out  
24 and splay (bloom). Thus, the Examiner’s concern  
25 in regard to considering the Sheppard affidavits in  
26 regard to the independent claims since the  
27 affidavits discuss the towels having been sheared  
28 is not relevant in considering claims 28 and 35 as  
29 these claims call for shearing. Note also that

Sherrill describes blooming to be a natural consequence of shearing. Reversal of the rejection is requested.

(Br. 24).

To the extent that this statement can be understood to be an argument that the prima facie case of obviousness against claim 28 is erroneous, the statement is not persuasive. The Appellant concedes that Sherrill teaches shearing. The Appellant appears to concede that Sherrill teaches the fibers being bloomed as a natural consequence of shearing. The Appellant does not contest the combination of the teachings of Sherrill with the teachings of Terrasse and Stark. In short, the Appellant provides no reason not to sustain the rejection of representative claim 28.

*Fifth Issue*

Inasmuch as we have concluded that the subject matter of claims 21, 22, 24-30 and 32-36 would have been prima facie obvious, and since the Appellant has submitted evidence in rebuttal of obviousness, we now turn to consider this evidence. When such evidence is presented it is our duty to consider the evidence anew. *See, e.g., In re Eli Lilly & Co.*, 902 F.2d 943, 945 (Fed. Cir. 1990). We also are mindful that objective evidence of nonobviousness in any given case may be entitled to more or less weight depending on its nature and its relationship with the merits of the invention. *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1539 (Fed. Cir. 1983).

The Appellant presents two affidavits, an “Affidavit under 37 C.F.R. 1.132” [“Affidavit”] and a “Supplemental Affidavit under 37 C.F.R. 1.132” [“Supplemental Affidavit”], both executed by the Appellant.



1       The Affidavit describes a commercial product, the EDGE towel. The  
2 Appellant does not aver that the EDGE towel is within the scope of any  
3 claim on appeal, although the Appellant’s counsel refers to the EDGE towel  
4 in the Appeal Brief as “the towel of claim 21.” (*See, e.g.*, Br. 17). In the  
5 words of the Appellant’s counsel, the Appellant in the Affidavit “explains  
6 why the towel of claim 21 was counterintuitive in that it would not have  
7 been obvious to add further cost to a high cost towel by applying a graphic  
8 image. The prior art taught that graphic images were printed on low end  
9 towel, not high end jacquard woven towels as in claim 1.” (*Id.*)

10       The Appellant’s statement that the discovery that “the graphic image  
11 was more crisp and sharp” on the EDGE towel than on other towels was an  
12 “unexpected benefit” (Affidavit 2) is entitled to little weight as evidence of  
13 an unexpected result. The statement is conclusory and without comparative  
14 data to explain or support it. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir.  
15 1997)(“[I]t is well settled that unexpected results must be established by  
16 factual evidence.”). Neither has the Appellant provided persuasive evidence  
17 that the claimed subject matter solves a long felt need. The Appellant’s  
18 statement that “[w]e haven’t had a customer who has been able to figure  
19 out how we have produced this product which I believe contributes to its  
20 uniqueness and is an indication of the nonobviousness of the invention” also  
21 is entitled to little weight. The Affidavit does not describe level of skill of  
22 these customers.

23       The Affidavit also alleges commercial success. More specifically, the  
24 Appellant states in the Affidavit that “[t]his product has been immensely  
25 successful and in three short years it now dominates 50 percent of total  
26 production, competing with 300 other different products in the Devant line

1 including jacquard woven and image dyed products.” (Affidavit 1-2). The  
2 Appellant in the Supplemental Affidavit states that the EDGE towels have a  
3 greater margin of profitability than Devant’s remaining products.  
4 (Supplemental Affidavit at 1). The Supplemental Affidavit provides a table  
5 supporting these statements. Nevertheless, while the Appellant’s  
6 commercial evidence is entitled to some weight, that evidence is not entitled  
7 to persuasive weight.

8       The weight of the Appellant’s commercial evidence is discounted by  
9 the Appellant’s failure to show a nexus between the EDGE towel and the  
10 claimed subject matter. *See Ex Parte Jellá*, 90 USPQ2d 1009, 1015 (BPAI  
11 2008)(precedential)(concluding that an applicant has a burden to establish a  
12 nexus between the claimed subject matter and any evidence of secondary  
13 indicia of obviousness). The Appellant does not even describe the EDGE  
14 towel so that it might be compared to the limitations of the claims on appeal.  
15 The weight of the Appellant’s commercial evidence is further discounted  
16 because the Appellant provides evidence of its own sales figures but no  
17 context in which to compare those sales figures to those of others in the  
18 market. The Appellant has not shown that the Appellant’s sales of the  
19 EDGE towel were a substantial quantity in a relevant market. *See id.* at  
20 1017 (concluding that evidence of sales without a showing that the sales  
21 were a substantial quantity in the relevant market is, at best, a weak showing  
22 of commercial success). The percentage of sales of EDGE towels as  
23 opposed to other products within Devant’s business is a statistic at least  
24 partially within Devant’s control which might reflect other factors (such as  
25 investment of manufacturing capacity or advertising resources) unrelated to  
26 the non-obviousness of the claimed subject matter.

1 Finally, the Appellant presents two letters, one from the Appellant to a  
2 competitor and one from another competitor to the Appellant, as evidence of  
3 copying. While this evidence is also entitled to some weight, its weight is  
4 discounted by the lack of any description by which to determine whether the  
5 alleged copies met the limitations of the claims on appeal. The weight of  
6 the evidence is also discounted by the Appellant's failure to produce any  
7 evidence, apart from the Appellant's own speculation, that the competitors  
8 copied the EDGE towel due specifically to the subject matter of the claims  
9 on appeal. Although the accused copyists appear to have agreed to stop  
10 producing the alleged copies, this may have been due to the threat that  
11 Devant might enforce extant patent rights rather than recognition that the  
12 non-obviousness of the subject matter of the claims which are the subject of  
13 the present appeal. It is not clear from either letter that the accused copyists  
14 even had access to the claims on appeal at the time the letters were written.

15 Having now considered all of the evidence of non-obviousness  
16 presented by the Appellant and after weighing the evidence anew, we  
17 conclude that the probative value of the evidence of obviousness outweighs  
18 the probative value of the evidence of non-obviousness. The Appellant  
19 has not established any secondary indicium of non-obviousness by a  
20 preponderance of the evidence. Although the Examiner's reasoning in  
21 support of the conclusion of obviousness relies on common sense and  
22 inferences drawn from comparison of the prior art structures with the  
23 claimed subject matter, the Examiner has provided sufficient evidentiary  
24 underpinnings to justify the Examiner's reliance on these factors. In view of  
25 the Appellant's failure to provide evidence probative of a nexus between the  
26 Appellant's evidence and the claimed subject matter, as well as the other

discounting factors discussed above, the weight of the evidence as a whole supports the Examiner's conclusion of obviousness.

## CONCLUSIONS

The subject matter of representative claim 21 would have been prima facie obvious.

More specifically, a towel as recited in claim 21, in which a border of a first darker color on a first side was capable of masking a graphic impression that might overlap onto the border from a central area of the first side, would have been prima facie obvious.

A towel as recited in claim 21, in which a central area of the first darker color on the second side was capable of masking any potential bleed through of the graphic impression from the central area of the first side, would have been prima facie obvious.

The subject matter of representative claim 28 would have been prima facie obvious.

The probative value of the evidence of obviousness produced by the Examiner outweighs the evidence of non-obviousness produced by the Appellant.

We sustain the rejections of claims 21, 22, 24-27, 29, 30, 32-34 and 36 under § 103(a) as being unpatentable over Terrasse and Stark; and the rejections of claims 28 and 35 under § 103(a) as being unpatentable over Terrasse, Stark and Sherrill.

DECISION

We AFFIRM the Examiner's decision rejecting claims 21, 22, 24-30 and 32-36.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

JRG

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